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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,807	08/19/2002	Jurg Paul Haller	P 6772.1 US	5715

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EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 07/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/064,807

Applicant(s)

HALLER ET AL.

Examiner

John R. Paradiso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is in claim form/language.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1-7, 9, 18-25, 28-29, and 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by GUNTER, JR. ET AL (US 4071997).

GUNTER, JR. ET AL discloses a device for enveloping inserts in an envelope, in which a first article (6) and a second article(s) (5) are fed from a supply to a deflector (25) which directs the first article along a first path (upward) to an insert folding station (50). The second article is directed along a second, generally parallel path along a transport means (41). The second article is passed beneath a stationary adhesive applicator (47), which applies lines of adhesive to the first article along its edges. An erecting unit (61) positions the first article in an upright position before it is folded. (See GUNTER, JR. ET AL column 2 line 46 to column 4 line 18, column 4 line 42 to column 5 line 3, and figures 5A, 5B, 6, and 11.)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8, 11, 26-27, and 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNTER, JR. ET AL.

GUNTER, JR. ET AL discloses a device for enveloping inserts in an envelope, as described above.

GUNTER, JR. ET AL does not disclose whether the adhesive is a hot-setting or cold-setting adhesive.

Regarding claims 8 and 11, the adhesive disclosed in GUNTER, JR. ET AL appears to be cold-setting, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either hot-setting or cold-setting adhesive in the invention of GUNTER, JR. ET AL, whichever type was most desirable for the consumer market the envelopes would be directed to, since the examiner takes Official Notice of the equivalence of hot-setting and cold-setting adhesive for their use in the packaging art and the selection of any of these known equivalents to seal the envelope would be within the level of ordinary skill in the art.

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Regarding claims 26-27, it would have been an obvious matter of design choice to provide a flattened surface on part of the cylinder, since applicant has not disclosed that providing such a flattened portion solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any generally cylindrical surface that provided positive control and grip over the articles.

Regarding claims 30 and 34, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the folding elements adjustable in order to accommodate differing consumer needs, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

6. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNTER, JR. ET AL in view of HELM (US 3593486).

GUNTER, JR. ET AL discloses a device for enveloping inserts in an envelope, as described above.

GUNTER, JR. ET AL does not disclose any of the transport rollers being vacuum-equipped.

HELM discloses an envelope inserting device in which a cylinder (8) is used to direct the flow of envelopes by adhering the envelope to its surface by means of vacuum ports on the surface of the cylinder. The cylinder is linked to a vacuum source to provide the vacuum. (See HELM column 2 lines 31-54.)

Regarding claim 15, Applicant is given Official Notice that the use of friction coatings on rollers to facilitate the gripping for movement of papers and the like is notoriously well known in the art (and in everyday life, with every office photo-copier providing an example) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a friction coating to the gripping rollers in order to provide a more firm and secure grip.

Regarding claims 16-17, Applicant is given Official Notice that the use of sensors to detect the presence of papers and thereby signal a supply roller to shut off operation is notoriously well known in the art (and again, with the same example from everyday life – office photocopiers are often equipped with sensors that signal when papers are present or absent and thereby signal the transport rollers to cease operation, whether vacuum or friction or both).

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Reference Citations

7. The following prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:


- GINSBERG discloses an envelope inserter with adhesive sprays.
- GAMMONS ET AL discloses a packaging machine in which the package is folded diagonally.
- ZEMKE discloses an envelope inserter with a plurality of sensors, control systems, and multiple insert paths.
- HIDDING ET AL discloses an envelope inserter with multiple insert paths.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center receptionist.


Examiner John Paradiso: (703) 308-2825

July 14, 2003

Additional Phone Numbers:

Supervisor Rinaldi Rada: (703) 308-2187
Receptionist: (703) 308-1148
Customer Service: (703) 306-5648

Fax (Direct to Examiner): (703) 746-3253
Fax (TC 3700 Official): (703) 872-9302
Fax (TC 3700 After Final): (703) 872-9303